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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,040	11/21/2003	Brent J. Bollman	NSL-016	2812
27652	7590	07/07/2008		
JOSHUA D. ISENBERG JDI PATENT 809 CORPORATE WAY FREMONT, CA 94539			EXAMINER STOUTER, KELLY M	
			ART UNIT	PAPER NUMBER
			1792	
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			07/07/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,040

Applicant(s)

BOLLMAN ET AL.

Examiner

KELLY STOUFFER

Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18, 20-22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-22 and 24 is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Due to amendments filed 30 April 2008, the previous prior art rejections of claims 1-9 have been withdrawn. New grounds of rejection for these claims appear below necessitated by amendment. As to the rejection of claims 10-16 and 18, the applicant's arguments are not persuasive. The applicant argues that the change of solvent in Furendal is unpredictable and that there is no reasonable expectation of success. However, Furendal discloses in column 12 lines 33-50 that the solvent used to anneal the film may be a variety of solvents with a preferred boiling point of 35-120°C. The solvent used to dissolve the polymer in the Examples certainly fits into these boiling points as well. Furendal already broadly includes these solvents in his criteria of useful solvents. Therefore it would have been obvious to use the same solvent to dissolve as well as anneal the polymer, seeing as they fit the same criteria as given by Furendal and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Absent further evidence from the applicant, the applicant has not shown that this would be inoperable and unpredictable. Therefore, the previous rejections of claims 10-16 and 18 are maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant adds the limitation to claim 1 of "without other assistance" in the present amendment. While the applicant may have provided support for the species that was previously present in the claims "without heat treating the film after exposure to the vapor" the applicant certainly does not indicate that he had possession of the entire genus of "other assistance" at the time of the invention in the instant specification. Further, absence of a positive recitation in the disclosure does not provide reasonable support for a negative limitation in the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 10-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furendal et al.

Regarding claim 10, Furendal et al. discloses a method for forming an organic film, comprising dipping and evaporating a polymer solution (columns 11 and 12 et seq.) to form the organic layer, then exposing the organic layer to a vapor of a solvent for a period of time sufficient to render at least the outermost portion of the organic film insoluble in the solvent (abstract, column 8 lines 11-65, examples for solvent-only annealing). Furendal discloses in column 12 lines 33-50 that the solvent used to anneal the film may be a variety of solvents with a preferred boiling point of 35-120°C. The solvent used to dissolve the polymer in the Examples certainly fits into these boiling points as well. Therefore it would have been obvious to use the same solvent to dissolve as well as anneal the polymer, seeing as they fit the same criteria as given by Furendal

Art Unit: 1792

and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Also, the limitation of using the same solvent for dissolving the polymer, as well as annealing or cross-linking the polymer, would have been obvious because “a person of ordinary skill has good reason to pursue the known options with his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.” A person of ordinary skill in the art would have a finite set of solvents to pick from, those that have a boiling point of 35-120°C. Picking the same two solvents to serve both functions simplifies the process and prevents cross-contamination and would be the product of ordinary skill of the art and common sense. See *KSR International Co. v. Teleflex Inc.*, 550 U.S.--, 82 USPQ2d 1385 (2007).

Regarding claim 11, the film is a polymer film (column 2 lines 21-40).

Regarding claims 12-14, the many type of polymers that may be used in the invention are disclosed in column 6 line 47 – column 8 line 11.

Regarding claims 15-16, the possible organic solvents are disclosed in column 12 line 55 – column 15 line 15.

As to claim 18, Furendal et al. is described above and does not include specific organic solvents for the polymer material to make the film, just that the solvent may be an inert volatile molecule. Furendal et al. does teach inert volatile molecules for use as the second solvent in 12 line 55 – column 15 line 15 that includes chloroform (column 14 ~line 42). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a small organic molecule such as chloroform, making both of the

Art Unit: 1792

solvents the same as required in claims 17-18, or any other small organic molecule making the solvents different as required by claim 19, as Furendal et al. implicitly recognizes the inherent suitability of doing such. In addition, one of ordinary skill in the art would recognize that choice of a solvent to form the film would depend upon the film desired to be formed, thus solvent choice is a result effective variable and its modification is not inventive. Therefore, it would have been obvious to one of ordinary skill in the art to modify Furendal to use chloroform to form its films instead of water due to the nature of the polymer deposited and by routine experimentation, absent evidence showing a criticality for the claimed solvent.

Allowable Subject Matter

Claims 20-22 and 24 are allowed for reasons discussed in the previous office actions.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 1792

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY STOUFFER whose telephone number is (571)272-2668. The examiner can normally be reached on Monday - Thursday 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kelly Stouffer
Examiner
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Art Unit: 1792

kms

/Timothy H Meeks/
Supervisory Patent Examiner, Art Unit 1792